

REMARKS

Claims 1 through 20 remain in this Application. As previously presented, claims 7 through 13 have been allowed and claim 17 was indicated to be allowable. Prior allowance of claims 14 through 20 was withdrawn.

Independent claim 1 has been amended to specify that the tool is for cutting and measuring drywall during a cut utilizing a tape measure having a blade and, further, to specify that the first and second resilient clips are each receivable at a different one of the first and second housing portions, respectively, to further define the tape measure blade receiving slot when the first and second housing portions are assembled so that a tape measure blade received in the slot for combined use of the tape measure and the tool during a cut is cooperatively releasably gripped between the resilient clips (see pages 8 and 9 of the Specification for support for this amendment). Specification of a saw blade (added by the previous amendment and prior to the new grounds for rejection and claim 1) in claim 1 has been deleted, this subject matter now found in claim 4.

Claim 2 has been amended in view of the objection thereto to replace the word "expansive" with "extensive"

(defined commonly as having a wide or considerable extent or scope). Withdrawal of the objection is requested.

Independent claim 14 has been amended to include the subject matter formerly specified in dependent claim 17 (including intermediate claims 20 and 16). Different subject matter is now found in dependent claims 16, 17 and 20, and various ones of the claims dependent directly or indirectly on claim 14 have had dependency changed in view of these amendments (in particular, claim 19 which also resolves the rejection of this claim under 35 USC 112, second paragraph).

Since claim 17 was indicated to be allowable, claim 14 as now presented should be allowed. Dependent claims 15 through 20 should be allowed when independent claim 14 is allowed.

The Examiner has rejected independent claim 1 under 35 USC 103(a) as being unpatentable over the teachings in the U.S. patent to Goldwitz in view of the teachings in the U.S. Patents to Collins and Canino. The Canino reference is cited for its teachings of a saw blade and is thus no longer relevant to claim 1 (in view of the claim amendment) or to the discussion which follows.

The Collins reference is new to this prosecution and is cited for a single sentence in column 6 lines 21 to 25

referring to projecting resilient clips that, while neither shown nor taught structurally in any way in the Collins patent, are said to be utilizable as an alternative to the retention nut 104 to secure tools pivotable from the end of the knife in the retracted and stored position in tool cavity 70 (a large rectangular detent in the side of the knife housing).

To establish a prima facie case of obviousness, the burden is initially on the Examiner to show that the prior art references teach or suggest all the claim limitations and to identify in the prior art some motivation for the suggested modification of the teachings of the primary reference (see MPEP section 2142 citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991)).

It is felt that there is no teaching or suggestion in either the Goldwitz or Collins patents of a cutting and measuring tool that includes first and second resilient clips that are receivable at the different housing portions assembled to form a mount as now clearly specified in claim 1. Moreover, there is no teaching or suggestion in these references that these clips further define a tape measure blade receiving slot when the housing portions are assembled, or that, when thus assembled, a tape measure blade received in the slot for

combined use of the tape measure and the tool during a cut is cooperatively releasably gripped between such resilient clips as specified in claim 1.

There is no teaching in the Collins reference whatever to suggest the structure or location of the proposed clips, whether they are unitary (like a cabinet catch) or plural, where they might be mounted to accomplish any stated goal, whether, if plural, it is only because there are plural tools or otherwise. It is just as likely from the one sentence "teaching" of the Collins patent that clips which might suggest themselves for use in the rectangular detent of Collins to receive and retain round shafted tools being pivoted from the end of the detent would not likely find or suggest themselves for use in a slot of the type under consideration in the Goldwitz patent. In short, the Collins patent is felt not to meet the basic requirement of a reference that it teach what it proposes, and therefore the proposal by itself cannot further the teaching of the prior art for purposes of a rejection under 35 USC 103(a). It is further felt that the combination of patents applied in this obviousness rejection suggests itself only by utilization of hindsight (i.e., that the actual

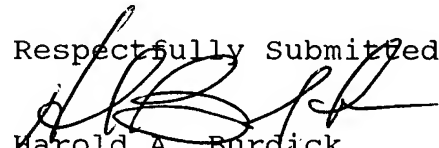
motivation really originates in the teachings of the patent application here under examination).

In view of the foregoing, it is felt that claim 1 as now presented is allowable over the cited and applied references and should now be allowed. Claims 2 through 6 are dependent, directly or indirectly, on claim 1 and should be allowed with the independent claim.

The period for response has been extended (for one month, from March 28, 2007 to April 28, 2007) by Petition for Extension of the Period for Response and fee (\$60.00 for a small entity) submitted herewith.

In view of the foregoing, it is felt that all of the claims now remaining in this Application are allowable, and accordingly, allowance of these claims, followed by passage of this Application to issue, is respectfully solicited.

Respectfully Submitted,

  
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